

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Eugene A. Helmsie
Serial Number: 10/774,339
Filed: February 6, 2004
Group Art Unit: 3751
Examiner: Le, Huyen D
Title: Configurable Modular Shower Surround Features

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Dear Sir:

The following remarks are in reply to the Examiner's Answer date March 1, 2011. The Appeal Brief fee has already been paid. Any additional fee or credit may be charged to Deposit Account No. 50-1482 in the name of Carlson, Gaskey & Olds.

Remarks

According to §2111.02 of the MPEP discusses whether the preamble has patentable weight in a case. Whether it does should be decided on a case-by-case basis in light of the facts in each case. There is no litmus test defining one of preamble limits the scope of the claim. However, if the claim preamble is "necessary to give life, meaning, and vitality to the claim, then the claim preamble should be construed as if in the balance of the claim." Citing *Pitney Bowes Inc. v. Hewlett Packard Co.*, 182Fed3rd 1298, 1305, 51 USPQ 2nd 1161, 1165-66 (Fed Circuit 1999).

In the instant case, the preamble is clearly and definitely of importance in construing this claim. According to the Board's previous decision in this case, on September 28, 2009 on page 19 thereof, the board overturned the Examiner's §103 rejection of Kitamura in view of Randall. As stated by the Board:

"the Appellants essentially argued that one of ordinary skill would not utilize the screws 31 and corresponding screws in the screw holes of Randall in Kitamura's shower surround because they would 'penetrate through the wall and provide a water path for water leakage into the wall cavity.'"

The Board agreed stating:

"we fail to see how one of ordinary skill in the art would consider screw holes covered by a shelf to be blind opening, and are persuaded that one of ordinary skill in the art would not use the screws and screw holes of Randall in the manner suggested by the Examiner because the potential for water intrusion."

In making this rejection, the Board essentially stated two things:

- 1) Because the application is for a shower, one would not to look art which required screw holes e.g., the preamble gives life and meaning to the claims; and
- 2) The Board stated exactly, "we fail to see how one of ordinary skill in the art would consider screw holes covered by a shelf to be a blind opening." (see page 19 lines 11-15 of the Board's decision in this case on September 28, 2009). Please note that Armstrong has screws 13 and holes (see Figs. 3&5) that support the shelves which would also provide water paths like those shown in Randall.

Because Armstrong does not show blind openings, like Randall, the rejection of claims 18 (the only independent claim in the case), 21-27, 30 and 33 under 35 U.S.C. §102(b) over Armstrong §102(b) rejection can therefore not stand and must be reversed. Armstrong provides the same water holes because of, as the Board cited on page 19 of its prior Decision, "the potential for water intrusion."

Please note that claims 28 and 29 also depend from allowable claim 18 as stated hereinabove and are therefore allowable as depending from allowable claim 18.

It is respectfully requested that all other arguments made hereinbefore have full effect as if made herein.

Respectfully submitted,

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